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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,669	08/02/2001	Charles C. Freeny JR.	2551.062	6710

30589 7590 04/28/2004

DUNLAP, CODDING & ROGERS P.C.
PO BOX 16370
OKLAHOMA CITY, OK 73113

EXAMINER

COURTENAY III, ST JOHN

ART UNIT	PAPER NUMBER
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2126

11

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,669

Applicant(s)

FREENY, CHARLES C.

Examiner

St. John Courtenay III

Art Unit

2126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2-27-04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


ST. JOHN COURTENAY III
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

The petition to withdraw the holding of abandonment was granted by the Office (paper #9, mailed April 22, 2004).

The amendment response received Jan. 14, 2004 adds new dependent claims 2-5, and provides a substitute specification. A duplicate substitute specification and a set of formal drawings were received on Feb. 27, 2004.

Page 7 of the response received Jan. 14, 2004 states: "Submitted herewith is a terminal disclaimer in compliance with 37 C.F.R. 1.321(c)."

However, as of April 27, 2004, no terminal disclaimer has been received. Accordingly, the obviousness-type double patenting rejection is restated below and this action is made final. The rejection of new dependent claims 2-4 is necessitated by Applicant's amendments.

Obviousness-type double patenting Rejection:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

"Double patenting rejection of application claims was fully justified where applicant, in course of expanding first application to disclose enough more by way of details, alternatives, and additional uses to support broad, dominating, generic claims in later applications, has disclosed no additional invention or discovery other than that what was already claimed in patent on first application; there is significant difference between justifying broadening of claims and disclosing additional inventions." In re Van Ornum, 214 USPQ 761 (CCPA 1982).

Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of co-pending application 09/014,859, now U.S. Patent 6,243,743 (Freeny).

Although the conflicting claims are not identical, they are not patentably distinct from each other because of corresponding language that recites virtually all of the same elements and functions claimed in the previously patented invention; e.g., instant claim 1 differs only from claim 1 of U.S. Patent 6,243,743 with respect to the text shown in bold and underlined below:

"A split personal computer system for selectively processing video portions, input/output portions, computational portions and storage portions of personal computer tasks, comprising:

- a remote portion adapted to selectively perform the computational portions and the storage portions of the personal computer tasks, **the remote portion having a master operating software system stored thereon**;

- a local portion adapted to selectively perform the video portions and the input/output portions of the personal computer tasks, the local portion comprising:
 - a display unit located remotely from the remote portion of the split personal computer system;
 - an accessory unit in communication with the display unit;
 - an input unit in communication with the accessory unit to input data signals into the accessory unit;
 - communication means for interfacing the accessory unit with the remote portion of the split personal computer system for permitting data signals received by the accessory unit from the input unit to be transmittable from the accessory unit to the remote portion of the split personal computer system, the data signals being processable by the remote portion of the split personal computer system to generate output signals, the output signals including video signals and being transmittable from the remote portion of the split personal computer system to the accessory unit, and transmittable from the accessory unit to the display unit.”

The instant claimed additional limitation, i.e., “the remote portion having a master operating software system stored thereon” is inherent as an operating system is a necessary component of a personal computer system and would therefore be obvious to a programmer of ordinary skill; the instant claim is merely a minor obvious variation of the base claims recited in the co-pending case.

Terminal Disclaimer

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of

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record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

For post GATT applications, (i.e., applications filed after June 8, 1995), the rule § 1.321 (4) (c) (3) requires a provision that must be included. The following requirement is UNCHANGED by GATT and therefore a terminal disclaimer is required for the instant application, i.e., "shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection."

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in **37 CFR 1.136(a)**. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to **37 CFR 1.136(a)** will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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How to Contact the Examiner:

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **St. John Courtenay III** whose voice telephone number is **(703) 308-5217**. A voice mail service is also available at this number. Normal Flex work schedule: M – F 7:30 AM - 4:00 PM

- **All responses sent by U.S. Mail should be mailed to:**

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Patent Customers advised to FAX communications to the USPTO

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/faxnotice.pdf>

Effective Oct. 15, 2003, ALL patent application correspondence transmitted by FAX must be directed to the new PTO central FAX number:


**NEW PTO CENTRAL FAX NUMBER:
703-872-9306**

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- Any inquiry of a general nature or relating to the status of this application should be directed to the **TC 2100 Group receptionist: (703) 305-3900**.

Please direct inquiries regarding fees, paper matching, and other issues not involving the Examiner to:

Technical Center 2100 CUSTOMER SERVICE: 703 306-5631

The Manual of Patent Examining Procedure (MPEP) is available online at:
<http://www.uspto.gov/web/offices/pac/mpep/index.html>


**ST. JOHN COURTENAY III
PRIMARY EXAMINER**